



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Arthur S. Robb	Examiner:	J. M. Akaarup
Serial No.:	10/670,555	Group Art Unit:	3714
Filed:	9/23/2003	Docket:	49673.21790US
Title:	Lottery and Gaming Systems with Multi-Theme Instant Win Games		

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**REPLY BRIEF**

Mail Stop: Appeal Brief  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed January 30, 2007, the following arguments are made. A separate "Request for Oral Hearing" is being filed concurrently.

All arguments made in the Appeal Brief received November 2, 2006, are repeated. In addition the following arguments are made in response to the positions set forth in the Examiner's Answer.

**1. Rejection of claims 1-8 and 10-12 under 35 U.S.C. § 102(e) as anticipated by Caro**

**a. "the outcome of the instant win game being independent from the base wagering claim"**

All of the claims subject to this rejection require that the outcome of the instant win game is independent from the outcome of the base claim. In the Final rejection, the Examiner's position was two-fold. The Examiner first referred to

[0049] of Caro for describing this claim limitation. Final rejection, page 3. Second, the Examiner made reference to certain disclosure in Penrice. Final rejection, pages 15-16. In response, Appellant argued that it could not be determined how [0049] of Caro describes this claim limitation and that any reference or reliance upon Penrice in this regard was improper as the rejection is one of anticipation based upon Caro alone. Appeal Brief, pages 9-11.

In stating this rejection in the Examiner's Answer, the examiner continues to rely upon [0049] of Caro as describing this limitation. Examiner's Answer, page 4. In responding to Appellant's arguments made in the Appeal Brief in this regard, the Examiner no longer makes reference to Penrice but makes a new reference to [0045] of Caro. Examiner's Answer, page 16. Thus, the rejection is based upon Caro by itself.

In responding to the arguments made in the Appeal Brief in regard to this claim limitation, the Examiner merely states that he disagrees with the argument and again points to [0049] of Caro as well as making a new reference to [0045] of Caro. Examiner's Answer, page 16. As explained at pages 9-11 of the Appeal Brief, [0049] of Caro simply does not describe this claim limitation. Rather, the outcome of the instant game described in Caro is dependent upon the outcome of the base wagering game. See, e.g., Caro, [0020]. The lack of a substantive response by the examiner to the detailed arguments made in the Appeal Brief is telling.

Nor does the Examiner's new reliance upon Caro [0045] aid his cause. This section of Caro reads:

[0045] A feature of the present invention is that the player also has the option of playing an instant game, as well as a future lottery game, typically a draw game, by paying a further amount, e.g. \$1 or \$2, and entering, whether himself or through the agent, a “Yes” or like indication of an intent to play the optional instant game. This selection, a “Yes” or “No” on playing the optional instant game, is also transmitted from the terminal to the central computer 20 where this choice is recorded in the memory 22 along with the other

information relating to this wager. The central computer then directs the terminal to print a single game ticket 12 that has printed, or otherwise recorded thereon, the player-selected first set 26 of numbers, and a visual indication 28 of the player’s choice as to whether or not to participate in an instant game. As shown in FIGS. 2A and 2B, this indication 28 is the word “Yes” or “No” following a written reference to the play of the instant game, or an equivalent such as the name of the particular instant game being played.

As seen, this paragraph only describes that an instant win game can be played in conjunction with a base wagering game. It says nothing about whether the outcome of the instant win game is independent of the outcome of the base wagering game. Thus, the Examiner’s new reliance to [0045] of Caro does not support the rejection.

For the reasons set forth in the Appeal Brief and above, Caro does not describe this claim limitation.

**b. “storing a plurality of instant win game outcome display themes”**

In considering this claim limitation, the phrase “game outcome display theme” must be properly construed. As explained at pages 11-12 of the Appeal Brief, the specification of this application contains enlightenment concerning the meaning of the phrase “game theme” as used in the claims on appeal. For example, the specification at [0037] describes the present technology as including software that causes tickets to be printed containing instant win game themes such as blackjack, bingo or football. When the claims are read in view of this enlightenment, as they must, In re Morris, 127 F.3d 1048, 1054, 44

USPQ2d 1023, 1027 (Fed. Cir. 1997), it is seen that a game outcome display theme according to the technology described in this application is more than a mere name as described in Caro.

The Examiner relied upon [0041], [0045] and [0046] of Caro in regard to this limitation in the Final rejection. Id., page 3. In stating the rejection in the Examiner's Answer, the Examiner continues to rely upon these paragraphs. Id., page 4.

As explained in the Appeal Brief at pages 11-12, [0041] of Caro is describing different manners in which random numbers can be generated, not an instant game display theme. Id., pages 11-12. The numbers chosen by any of these methods are stored as a number, not as a theme. The stored numbers can be used to determine the outcome of the instant win game of Caro but not as a theme of the instant win game of Caro.

Appellant also explained at pages 11-12 of the Appeal Brief that [0045] of Caro, at best, identifies the instant win game by name only, not by a game theme as required by the claims subject to this rejection. [0046] of Caro only indicates that other indicia can be used on the ticket to indicate that the player has an option to play an instant win game. Such indicia are not an instant win game theme according to the technology described in this application.

The Examiner also continues to refer to Figs 3A-3B as illustrating a Pick 3 or Pick 4 game and states that these are examples of instant win game outcome display themes. Examiner's Answer, page 4. This is incorrect. The Pick 3 or Pick 4 "format" illustrated in Figs. 3A-3B of Caro is not an instant win game theme. Rather, the illustrated Pick 3 and Pick 4 formats are for the base wagering game of Caro, not the instant win game. See Caro [0052]. This point was made at page 11 of the Appeal Brief but was ignored by the examiner. The instant win

game illustrated in these figures is merely identified by the nondescript name "Key number match."

For the reasons set forth in the Appeal Brief and above, Caro does not describe this claim limitation.

**c. "displaying the outcome of the instant win game with a theme"**

As set forth above, Caro does not describe storing a plurality of instant win game themes. Thus, Caro cannot describe displaying the outcome of the instant win game with a theme. The examiner continues to assert at page 17 of the Examiner's Answer that Caro "discloses ... different themes such as physical drawing of number, or an occurrence of some public event such as stock price on a given day or score in a sporting event ... which are the theme[s] stored in the memory and can be used to determine the outcome of the instant win game." Again, these events are described in Caro at [0041] as being a random number generator, not an instant win game theme. The numbers chosen by any of these methods are stored as a number, not as a theme. The stored numbers can be used as a number to determine the outcome of the instant win game of Caro but not as a theme of the instant win game of Caro.

For the reasons set forth in the Appeal Brief and above, Caro does not describe this claim limitation.

**d. "storing a game theme indicator"**

The Examiner states at page 4 of the Examiner's Answer that a game theme indicator can be in the form of the type or name of the instant win game. As explained at pages 11-12 of the Appeal Brief, the specification of this application contains enlightenment concerning the meaning of the phrase "game theme indicator" as used in the claims on appeal. For example, the specification

at [0037] describes the present technology as including software that causes tickets to be printed containing instant win game themes such as blackjack, bingo or football. When the claims are read in view of this enlightenment, as they must, In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), it is seen that a game theme indicator according to the technology described in this application is more than a mere name as described in Caro.

The Examiner responds to this argument in conjunction with the response to the limitation “displaying the outcome of the instant win game with a theme.” Examiner's Answer, page 17. As set forth in section 1 c. above, the examiner's position in regard to this claim limitation is incorrect.

For the reasons set forth in the Appeal Brief and above, Caro does not describe this claim limitation.

## **2. Rejection of claims 9 and 13-20 under 35 U.S.C. § 103(a) based upon Penrice and Caro**

As explained at pages 13-16 of the Appeal Brief, Caro does not describe at least at least four of the elements of these claims, viz., the outcome of the instant game being independent from a base game, storing a plurality of instant win game outcome display themes, displaying the outcome of the instant win game with a theme, and storing a game theme indicator. The Examiner admits that Penrice does not describe “a lottery game that includes a base game and an instant win game.” Examiner's Answer, page 9. Thus, the Examiner is relying upon Caro to make up for this lack of description in Penrice.

For the reasons set forth in the Appeal Brief and those above, it is submitted that Caro does not describe any of these four claim limitations. Since a conclusion of obviousness must be based upon the subject matter of a claim as a whole, 35 U.S.C. § 103(a), the examiner's combination of Penrice and Caro fails.

**Conclusion**

In view of the foregoing remarks and the arguments set forth in the Appeal Brief, Appellant submits that the Examiner's rejections are in error and should be reversed.

Respectfully submitted,  
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Date 21 February 2007

**CERTIFICATE OF MAIL**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage thereon in an envelope addressed to Mail Stop: Appeal Brief, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

  
Lucille Golden-Blakey

Dated: February 21, 2007